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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/715,725	11/16/2000	Ying Luo	A-68289-1/RMS/DHR	6653

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EXAMINER	
HUNT, JENNIFER ELIZABETH	
ART UNIT	PAPER NUMBER

1642

DATE MAILED: 03/27/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/715,725	LUO ET AL.	
	Examiner	Art Unit	
	Jennifer E Hunt	1642	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-25 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-10, drawn to a nucleic acid, vector, host cell, and method of making a polypeptide, classified in class 536, subclass 23.1, and class 435, subclass 320.1 and 325.
 - II. Claims 11-14, drawn to a protein, classified in class 530, subclass 350.
 - III. Claims 15-18, drawn to a polypeptide which binds a protein, classified in class 530, subclass 387.1.
 - IV. Claim 19, drawn to a method of screening for an agent capable of binding, classified in class 436, subclass 501.
 - V. Claims 20-21, drawn to a method of screening for an agent capable of inhibiting, classified in class 436, subclass 64.
 - VI. Claims 22-23, drawn to a method of screening for an agent capable of modulating activity, classified in class 514, subclass 44.
 - VII. Claims 24-25, drawn to a method of modulating tumor growth, classified in class 514, subclass 2.
2. The inventions are distinct, each from the other because of the following reasons:
 1. The inventions of Groups I-III are drawn to completely different products, having different chemical structures, and different physiological functions. The

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nucleic acid and corresponding vectors and host cells of Group 1 have a distinct structure and function from the protein of Group two, or the binding polypeptides and antibodies of Group III. All three of these distinct products have separate structures and perform different biological functions, and therefor would require different, non-cohesive searches.

2. The inventions of Groups IV-VII are different because they are all different methods, having different starting points, different method steps, and distinct outcomes. The method of Group IV uses a protein and an agent to determine binding. The method of Group V uses a protein and a second apoptosis inhibiting protein to determine an agent which blocks binding. The method of Group VI uses a cell having a recombinant nucleic acid and an agent to determine modulation of activity. The method of Group VI uses a protein to modulate tumor growth. All of these methods are different for the reasons detailed above, and thus are distinct and require different searches and consideration.

3. Inventions of Group I and VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product of Group I can be used for a materially different process, such as to make a polypeptide.

4. Inventions of Groups II and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown:

(1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product of Group II can be used for a materially different process, such as to modulate tumor growth or generate antibodies.

5. Inventions of Groups II and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown:

(1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product of Group II can be used for a materially different process, such as to modulate tumor growth, or generate antibodies.

6. Inventions of Groups II and VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown:

(1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product of Group II can be used for a materially different process, such as in screening assays, or to generate antibodies.

7. This application contains claims directed to the following patentably distinct species of the claimed invention:

If Group I, II, or III is elected, applicant must further elect a species of ING2 variant:

- A. SEQ ID NO's 1 and 2
- B. SEQ ID NO's 3 and 4
- C. SEQ ID NO's 5 and 6
- D. SEQ ID NO's 7 and 8
- E. SEQ ID NO's 9 and 10

The variants are distinct and require separate searches and consideration.

Thus election of species is proper.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37

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CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and because the search required for any one Group is not required for any other Group, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Hunt, whose telephone number is (703) 308-7548. The examiner can normally be reached Monday through Thursday 6:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa can be reached at (703) 308-3995. The fax number for the group is (703) 305-3014 or (703) 308-4242.

Communications via internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [anthony.caputa@uspto.gov].

All internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists the possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy


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published in the Official Gazette of the Patent and Trademark on February 25, 1997
at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or
proceeding should be directed to the group receptionist, whose telephone number is
(703) 308-0196.

Jennifer Hunt

3/25/02



ANTHONY C. CAPUTO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1000